

PATENT

Application No. 10/070,042

Filing Date: 07/18/2002

Examiner Neil S. Levy, Art Unit 1616

Attorney Docket No. von Kreisler.022

III REMARKS

A. Current Background

The examiner has allowed claims 3, 4, 7, 24 and 36. Claims 1, 2, 5, 6, 8–10, 12, 13, 19–21, 30, 43, 46 and 47 are rejected under 35 U.S.C. § 102(3) as anticipated by, or in the alternative, under 35 U.S.C. § 103 as obvious over United States Patent No. 6,207,290 to Blum et al. (the "Blum et al. patent"). Claim 48 was not examined.

**B. Applicant's Response To Rejections
Under 35 U.S.C. Sections 102(b) and 103(a)**

The examiner gave the following arguments in support of the rejections:

The rejection of record is maintained. The particular progenitor, inclusive of alcohol or propylene glycol, with any particular antioxidant inclusive of tannic acid, and with the conventional additives recited by Blum does not adversely [a]ffect the nature of the antifouling wood treatment composition, or method of treatment impregnation (col. 3, bottom) or spraying (col. 5, line 25). Tannin is present, as the earlier of tannic acid (col. 4, line[s] 61–63) and combinations are disclosed. Tannin, esters of tannic acid, and/or tannic acid are at least 0.01% and up to 10%, while solvents (examples) are at least 30%, thus obvious for one in the art to achieve the instant claim 8% or that of claim 19, 30, 43.

(Examiner's Action, paragraph bridging pp. 2–3).

Applicant believes that these rejections should be withdrawn because Applicant's claimed compositions are novel and unobvious over the compositions of the Blum et al. patent. Applicant's claimed compositions are also different in being non-toxic.

1. Differences between Blum et al.'s Anti-Oxidant Compositions and Applicant's Claimed Compositions

The antifoulant compositions disclosed in the Blum et al. patent contain 10,10¹-oxybisphenoxamine and/or phenarsazine oxide with a quarternary ammonium salt. (See Abstract, Field of Invention (at column, lines 8–10) and Summary of the Invention (at column 1, line 65 to column 2, line 2).

Applicant's claimed method for the impregnation and treatment of wood comprises the step of applying a composition to the wood that ***consists essentially of certain ingredients***. None of Applicant's claimed compositions include 10,10¹-oxybisphenoxamine and/or phenarsazine oxide with a quarternary ammonium salt.

The phrase "consisting essentially of" means that the composition excludes other ingredients of any essential significance to the claimed composition. Accordingly, Applicant's claims would not be open to 10,10¹-oxybisphenoxamine and/or phenarsazine oxide with a quarternary ammonium salt, as such ingredients would have essential significance to Applicant's claimed compositions.

2. Difference in Toxicity Between the Antifoulant Compositions of the Blum et al. Patent and Applicant's Claimed Compositions

The Blum et al. patent describes its antifoulant compositions as "far less toxic than organic arsenic compounds." (Column 3, lines 6–9). In other words, the antifoulant compositions are toxic to some degree.

Applicant has amended the rejected claims to recite that the claimed method employs non-toxic compositions. Support for the limitation is provided at page 2, lines 12–23. Further support is provided by the compositions at page 3, line 20 to page 4, line 2, and at page 18, lines 16–20, both of which incorporate the composition set forth in Applicant's claim 1. More specifically, claim 1 recites a composition consisting essentially of benzyl alcohol, which is

defined in the application as a GRAS (or “generally recognized as safe”) flavored alcohol (page 8, lines 1–3) and tannic acid, which is described as “a flavoring agent selected from polyphenol compounds (page 3, line 20 to page 4, line 2 and page 8, line 21 to page 9, line 14). Flavoring agents cannot be toxic.

Accordingly, a critical ingredient in the compositions disclosed in the Blum et al. patent is not an ingredient set forth in Applicant’s claimed compositions. In addition, the Blum et al. antifoulant compositions are at least somewhat toxic, while Applicant’s claimed compositions are not toxic. Hence, the rejection of Applicant’s claims 1, 2, 5, 6, 8–10, 12, 13, 19–21, 30, 43, 46 and 47 under 35 U.S.C. Section 102(b) or 35 U.S.C. Section 103(a) over the Blum et al. patent is untenable and should be withdrawn.

C. Claim 48

Applicant’s claim 48 has not been rejected or allowed. If it was the examiner’s intention to reject claim 48 under 35 U.S.C. § 102(c) and/or under 35 U.S.C. § 103(a) over the Blum et al. patent, Applicant’s arguments against the same rejection of claims 1, 2, 5, 6, 8–10, 12, 13, 19–21, 30, 43, 46 and 47 are incorporated by reference with regard to claim 48.

IV CONCLUSION

It is believed that the above constitutes a complete response under 37 CFR Section 1.111 and that all bases of rejection stated in the Official Action have been adequately rebutted and/or overcome. Accordingly, a Notice of Allowance of United States Patent Application Serial No. 10/070,042 is requested as the next Office Action. The examiner is requested to telephone the undersigned attorney if any matters that can reasonably be expected to be resolved in a telephone interview are believed to impede the allowance of the pending claims.

Respectfully submitted,

DANN DORFMAN HERRELL AND SKILLMAN


John S. Child, Jr.

PTO Registration No. 28,833
1601 Market Street
Suite 2400
Philadelphia, PA 19103-2307
TELEPHONE: 215-563-4100
FACSIMILE: 215-563-4044

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CORRESPONDENCE ADDRESS:
Customer No. 000110
John S. Child, Jr., Esquire
Dann Dorfman Herrell and Skillman
1601 Market Street, Suite 2400
Philadelphia, PA 19103-2307